

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on December 24, 2002, the Examiner indicated that objections to the drawings and to the abstract were withdrawn. However, the Examiner made an objection under 35 U.S.C. §132 and an objection under 35 U.S.C. §112, first paragraph. The Examiner further objected to claims 36-37 and rejected claims 21-40 under 35 U.S.C. §112, first paragraph. The Examiner further rejected claims 21-40 under 35 U.S.C. §103(a) as being unpatentable over Evans (U.S. Patent No. 5,924,074, hereinafter “Evans”) in view of Feldon et al (U.S. Patent No. 5,732,221, hereinafter “Feldon”). Accordingly, Applicant provides the following:

Objection under 35 U.S.C. § 132

In the Office Action, the Examiner made an objected under 35 U.S.C. §132, indicating that the recent amendment introduces new matter into the disclosure. In particular, the Examiner indicated that “a dynamically customizable form” appears to constitute new matter. Applicant respectfully disagrees that “a dynamically customizable form” constitutes new matter and provides the following to clarify the issue and to specifically point out support for the limitation in the originally filed disclosure.

In accordance with at least some embodiments of the present invention, a form is used to keep a patient record of the procedures performed and diagnosis given by a healthcare provider and/or at a particular facility. (page 5 lines 19-20, page 5 lines 4-6, and page 9, lines 20-22).

The term “customizable” is traditionally used to reference an ability to be modified, adapted or otherwise provided according to a specification or preference. In the present invention, a form used in association with providing a healthcare service to a patient is

customizable for at least the reasons that it is “customized to reflect specialties provided in that office” (page 5, lines 11-12), it reflects procedures depending on the type of patient, (page 11, lines 6-10) and/or it reflects procedures depending on the type of provider (page 11, lines 6-10).

The term “dynamic” is an antonym of the term “static,” which is traditionally used in the computer industry to describe being fixed or incapable of action or change. In the present invention, a form used in association with providing a healthcare service to a patient is dynamic for at least the reasons that patient records kept by the form can be generated in a real time setting (page 5, line 7), that objects on the form are selectable by a user (page 17 lines 23 to page 18 line 24), and/or that providing the first characters of a code positions the selectable entries closer to the desired code (page 17 line 23 to page 18 line 5).

Accordingly, for at least the reasons provided above, Applicant respectfully disagrees that “a dynamically customizable form” constitutes new matter since the limitation of “a dynamically customizable form” is supported by the specification, as originally filed, of the above-referenced application, and respectfully requests withdrawal of the objection.

Objection under 35 U.S.C. §112, first paragraph

In the Office Action, the Examiner objected to the specification under 35 U.S.C. §112, first paragraph, because the specification, as originally filed, does not provide support for the invention for the reason that “a dynamically customizable form” constitutes new matter. Applicant respectfully disagrees. For at least the reasons provided above, “a dynamically customizable form” is supported by the specification, as originally filed. Accordingly, Applicant respectfully submits that the specification satisfies 35 U.S.C. §112, first paragraph, and request withdrawal of the objection.

Claim Objections

In the Office Action, the Examiner objected to claims 36-37. Applicant respectfully submits that the amendments provided herein overcome the objection made to claims 36-37, and requests withdrawal of the objections.

Rejections under 35 U.S.C. § 112, first paragraph

In the Office Action, the Examiner rejected claims 21-40 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification for the reasons set forth in the objection to the specification above, namely that “a dynamically customizable form” appears to constitute new matter. Applicant respectfully disagrees and submits that for at least the reasons provided above, “a dynamically customizable form” is supported by the specification, as originally filed. Accordingly, Applicant respectfully submits that the rejection to claims 21-40 made under 35 U.S.C. 112, first paragraph, has been overcome for at least the reasons provided above.

Rejections under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claims 21-40 under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of Feldon. Evans discloses a medical records system that creates and maintains all patient data electronically. The system captures patient data, such as patient complaints, lab orders, medications, diagnoses, and procedures, at its source at the time of entry using a graphical user interface having touch screens. Using pen-based portable computers with wireless connections to a computer network, authorized healthcare providers can access, analyze, update and electronically annotate patient data even while other providers are

using the same patient record. The system likewise permits instant, sophisticated analysis of patient data to identify relationships among the data considered. Moreover, the system includes the capability to access reference databases for consultation regarding allergies, medication interactions and practice guidelines. The system also includes the capability to incorporate legacy data, such as paper files and mainframe data, for a patient. (Abstract)

Feldon teaches a system and method for generating written reports based on succinct input from a user. A method comprises entering a first mode for initialization; defining menus; entering a second mode for receiving information; entering information using the defined menus; interpreting the entered information; and generating a written report in response to the interpreting step. A system comprises a portable computer system having a memory, a processor, a detachable keyboard, a screen, and a pen. Ancillary information is entered with the keyboard which is then detached. Subsequent information is documented by selecting appropriate items from the defined menus; alternatively, the information can be written on the screen with the pen. The processor is programmed to interpret the inputs and generate a report. The report may be printed on a printer, stored on a storage device, and/or transferred to another system. (Abstract)

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the 35 U.S.C. § 103(a) obviousness rejection of claims 21-40 is improper because the first criterion is not met, since the references are not properly combinable and further teach away from each other.

Evans and Feldon are not properly combinable because Evans' intended function is destroyed by the combination of the references. Evans specifically provides that the "system transforms a patient chart from a static record ... into a dynamic, real-time comprehensive record linked to an enterprise-wide clinical database." (col. 2, lines 35-38) In contrast, independent claim 21 includes the limitations of "generating the dynamically customizable form for use by the healthcare provider in providing a healthcare service to a patient; and using the dynamically customizable form in association with providing the healthcare service to the patient." A similar limitation is also included in independent claim 33. It is a specific object of Evans to transform a patient chart from a static record to a comprehensive record. Applicant respectfully submits that the dynamically customizable form as claimed in the present invention eliminates the need of a static record and thus eliminates the ability to transform a static record into a comprehensive record, as is an object of Evans. Accordingly, Applicant respectfully submits that the combination of Evans and Felton is improper since the rejection is based upon a modification of Evans that destroys the intent, purpose or function of the invention disclosed in Evans, and thus the prima facie case of obviousness cannot be properly made.

Applicant respectfully submits that the combination of Evans and Feldon is further improper since Evans and Feldon teach away from each other, which demonstrates a lack of prima facie obviousness. Evans teaches providing "instant access to a patient's electronic medical record by authorized healthcare providers from any geographical location." (col. 2, lines 45-47) In contrast, Feldon teaches "generating written reports based on succinct input from a

user.” (Abstract) Thus, while Evans teaches providing access to a patient’s electronic medical record, including simultaneous access, from a plethora of locations anywhere in the world, Feldon teaches generating a single printed report that is only accessible by a single reader.

Since the combination fails to satisfy the first criterion listed in M.P.E.P. 706.02(j), the references do not establish a prima facie case of obviousness. And, even if the combination did satisfy the first criterion, Applicant respectfully submits that the combination of Evans and Feldon still would not satisfy a prima facie case of obviousness since under to third criterion the combination does not teach or suggest all the claim limitations, as hereinafter set forth.

Independent claim 21 includes the limitations of electronically selecting one or more healthcare procedures characteristically performed by a particular healthcare provider of a healthcare facility for inclusion in a dynamically customizable form; electronically selecting one or more healthcare diagnoses characteristically employed by the particular healthcare provider as a reason for performing the one or more healthcare procedures for inclusion in the dynamically customizable form; generating the dynamically customizable form for use by the healthcare provider in providing a healthcare service to a patient; and using the dynamically customizable form in association with providing the healthcare service to the patient by selecting: (i) one of the diagnoses characteristically employed by the particular healthcare provider; and (ii) one of procedures characteristically performed by the particular healthcare provider.

As mentioned by the Examiner in the Office Action, “Evans fails to expressly disclose ... selecting procedures and diagnoses for inclusion within the form.” (see page 6 of the Office Action) And, while Felton discloses editing existing forms or redesigning completely new forms (col. 4, lines 13-63), Felton does not disclose selecting healthcare procedures and diagnoses characteristically performed by a particular healthcare provider of a healthcare facility for

inclusion in a dynamically customizable form that is used in association with providing a healthcare service to a patient by selecting: (i) one of the diagnoses characteristically employed by the particular healthcare provider; and (ii) one of the procedures characteristically performed by the particular healthcare provider. Accordingly, since the references do not teach each and every limitation of claim 21, Applicant respectfully submits that claim 21 is not made obvious by the references cited by the Examiner for at least the reasons provided above. Similarly, since claims 22-29 and 31-32 depend from claim 21, Applicant respectfully submits that claims 22-29 and 31-32 are also not made obvious by the references cited by the Examiner for at least the reasons provided above.

Similarly, independent claim 33 includes the limitations of receiving a selection of one or more healthcare procedures characteristically performed by a particular healthcare provider of a healthcare facility for inclusion in a dynamically customizable form; receiving a selection of one or more healthcare diagnoses characteristically employed by the particular healthcare provider as a reason for performing the one or more healthcare procedures for inclusion in the dynamically customizable form; generating the dynamically customizable form for use by the healthcare provider in providing a healthcare service to a patient; and providing the dynamically customizable form for use by the healthcare provider in association with providing the healthcare service to the patient, wherein the step for providing the dynamically customizable form for use comprises the steps for: (i) selectively receiving a selection of one of the diagnoses characteristically employed by the particular healthcare provider; and (ii) selectively receiving a selection of one of the procedures characteristically employed by the particular healthcare provider.

As mentioned above, the Examiner indicated in the Office Action that “Evans fails to expressly disclose ... selecting procedures and diagnoses for inclusion within the form.” (see page 6 of the Office Action) And, while Felton discloses editing existing forms or redesigning completely new forms (col. 4, lines 13-63), Felton does not disclose receiving a selection of healthcare procedures and diagnoses characteristically performed by a particular healthcare provider of a healthcare facility for inclusion in a dynamically customizable form that is used in association with providing a healthcare service to a patient. Accordingly, since the references do not teach each and every limitation of claim 33, Applicant respectfully submits that claim 33 is not made obvious by the references cited by the Examiner for at least the reasons provided above. Similarly, since claims 34-38 and 40-41 depend from claim 33, Applicant respectfully submits that claims 34-38 and 40-41 are also not made obvious by the references cited by the Examiner for at least the reasons provided above.

CONCLUSION

Applicant respectfully submits that the claim set provided herein does not add new matter and is now in condition for allowance. Accordingly, Applicants therefore request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

Dated this 24th day of April, 2003.

Respectfully submitted,



Berne S. Broadbent
Attorney for Applicant
Registration No. 30,550

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 321-4814
Facsimile: (801) 321-4893

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